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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,328	10/16/2003	Jose F. Arena	7230-8	8505

7590 06/28/2006

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EXAMINER

SWITZER, JULIET CAROLINE

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,328

Applicant(s)

ARENA ET AL.

Examiner

Juliet C. Switzer

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, all in part, drawn to methods for analyzing a biological sample for the presence or a genetic polymorphism or mutation wherein the mutation is 4959C>T in the BRCA1 gene, classified in class 435, subclass 6.
 - II. Claims 1-10 all in part, drawn to methods for analyzing a biological sample for the presence or a genetic polymorphism or mutation wherein the mutation is 5217G>A in the BRCA1 gene, classified in class 435, subclass 6.
 - III. Claims 1-10 all in part, drawn to methods for analyzing a biological sample for the presence or a genetic polymorphism or mutation wherein the mutation is 1503A>C in the BRCA2 gene, classified in class 435, subclass 6.
 - IV. Claims 1-10 all in part, drawn to methods for analyzing a biological sample for the presence or a genetic polymorphism or mutation wherein the mutation is 5996A>C in the BRCA2 gene, classified in class 435, subclass 6.
 - V. Claims 1-10 all in part, drawn to methods for analyzing a biological sample for the presence or a genetic polymorphism or mutation wherein the mutation is 8688A>C in the BRCA2 gene, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II, III, IV and V are directed to related mehtods. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or

Art Unit: 1634

effect. See MPEP § 806.05(j). In the instant case, the related methods do not overlap in scope because each one specifically requires the consideration of a different polymorphism which is recited in the alternative in the independent claim. Further, groups I and II are drawn to the detection of a polymorphism in a distinct gene from the polymorphism recited in groups III, IV and V. Each method for detecting a unique polymorphism is not an obvious variant of the other, as each polymorphism has a different potential diagnostic effect and the polymorphisms result in different changes in the gene sequence of BRCA1 and BRCA2. Further, the inventions have a materially different mode of operation and design as they each require that different polymorphic positions be detected, which would require the use of different reagents, for example different nucleic acid probes or restriction enzymes specific to the polymorphism to be detected.

3. A further restriction requirement is required for claim 2, which recites a step of analyzing “at least two” of the recited polymorphisms or mutations. The claims read on a multitude of possible groupings of methods, each of which is separate and distinct one from another because they require analysis of combinations of polymorphisms that are structurally separate from one another. The search and examination of all possible groups would pose an enormous burden on the examiner and on the PTO search resources. In accordance with MPEP 803.04, applicant is required to select one combination of “at least two genetic polymorphisms or mutations” for examination with the elected group. The elected combination should include the polymorphism of the elected group. If a method reciting the single combination elected for claim 2 becomes allowable, methods which use the combination and any additional polymorphisms will all be rejoined.

Art Unit: 1634

4. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper. The search and examination of each different method for detecting each different polymorphism separately requires a different field of search in the patent and non-patent literature since different sequence searches and text searches are required for each polymorphic position. The reporting of polymorphism data in the prior art is not uniform and as a consequence for each individual polymorphic position a variety of different numbering designations is possible, and the search and examination of each requires its own attention. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In

Art Unit: 1634

either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Juliet C Switzer whose telephone number is (571) 272-0753. The examiner can normally be reached on Monday, Tuesday, or Thursday, from 9:00 AM until 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached by calling (571) 272-0735.


The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-0507.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of

Art Unit: 1634

document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.



Julie C. Switzer
Primary Examiner
Art Unit 1634

June 23, 2006